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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,228	01/18/2002	Erich Frauendorfer	1085-019	9083

7590 08/26/2004

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/052,228

Applicant(s)

FRAUENDORFER ET AL.

Examiner

Rabon Sergeant

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 14-23 and 25-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-23 and 25-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/5/03</u> . | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 14-23 and 25-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, within claim 14, the language, “the reaction”, lacks antecedent basis. It is unclear what reaction is being referred to.

Secondly, within claim 14, the language, “wherein the amine-N oxide has three residues that comprise no more than 8 carbon atoms”, is confusing, because it is unclear if the total number of carbon atoms for all three residues is not to exceed 8.

Thirdly, within claims 14 and 30, the language, “... comprise no more than 8 carbon atoms and optionally heteroatoms selected from the group consisting of nitrogen, oxygen, and/or sulfur”, renders the claims indefinite for two reasons. The first reason being that it is improper to specify members of a Markush group in the alternative when the language, “selected from the group consisting of”, is used. The second reason being that it is unclear how to interpret the “no more than 8 carbon atoms and optionally heteroatoms” language; the language can be interpreted as stating that no heteroatoms are optionally present.

Fourthly, within claims 14, 17, and 28, the language pertaining to the  $\beta$ -hydrogen atom is confusing, because applicants’ language, “the nitrogen atom having a  $\beta$ -hydrogen atom”, does not clearly correspond to the specification at page 9, lines 30 and 31. Within the specification, applicants associate the  $\beta$ -hydrogen atom with a hydrocarbon residue.

Fifthly, within claim 15, it is unclear what is meant by “part cyclic structures”.

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Lastly, given the limitations of claim 14, it is not clear that the subject matter of claims 15 or 17 further limit the claim. Given the "and/or" language and R groups comprising full or part cyclic structures within claim 15, it is not clear that this language further limits claim 14, wherein the three residues comprise no more than 8 carbon atoms.

2. Claims 33 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Support has only been found for the species, "dibutyltin mercaptite"; it is not clear that support exists for the genus of compounds encompassed by tin mercaptide.

Any inquiry concerning this communication should be directed to Rabon Sergent at telephone number (571) 272-1079.

R. Sergent

August 22, 2004

  
RABON SERGENT  
PRIMARY EXAMINER